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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,507	09/05/2006	Jianjun Wang	047911-0103	2372
22428 7590 03/25/2011 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			EXAMINER MEKHLIN, ELI S	
			ART UNIT 1728	PAPER NUMBER
			MAIL DATE 03/25/2011	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/574,507

Applicant(s)

WANG ET AL.

Examiner

ELI S. MEKHLIN

Art Unit

1728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-60, 62-76, 79 and 80 is/are pending in the application.
- 4a) Of the above claim(s) 65-74 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57-60, 62-64, 75, 76, 79 and 80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

(1)

Applicant's response filed March 10, 2011, has been entered. Claims 57-60, 62-76, 79 and 80 are pending before the Office for review. Claims 65-74 are withdrawn from further consideration due to a restriction requirement.

(2)

Response to Arguments

Applicant's arguments, see Remarks, filed March 10, 2011, with respect to claims 57-59, 75 and 79 have been fully considered and are persuasive. The rejection of the claims over Wu et al. *Adv. Mater.* **2002**, *14*, No. 1, January 4, Pages 64-67 in view of Mack et al. (U.S. Publication No. 2003/0224168) has been withdrawn. However, Examiner notes that Applicant has not addressed the portion of the rejection that is based on Wu et al. and portions of the MPEP. Specifically, Applicant has not addressed the fact that "where the only difference between the prior art and the claims [is] a recitation of the relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device [is] not distinct from the prior art device." MPEP 2144.04(IV)(A). Finally, although Applicant argues that Wu does not teach or suggest a nanostructure having a thickness of 2 nm or less, Applicant fails to address the rejection that is based on the overlap of ranges. Wu teaches a range of less than 10 nanometers and the MPEP makes clear that "where the claimed ranges overlap or lie inside ranges disclosed by

the prior art a *prima facie* case of obviousness exists. MPEP 2144.05(I) (internal quotations omitted). Therefore, this portion of the rejection is maintained.

Applicant's argument with respect to claim 60 is equally unpersuasive because it merely asserts that Peigney is a theoretical study. However, Examiner notes that Peigney teaches the expected SSA of a graphene sheet and Applicant has not presented any evidence as to why Peigney's study is inaccurate. Furthermore, Applicant has not addressed the other portion of the rejection that is based on the fact that Wu teaches a nanosheet having Applicant's dimensions, meaning the SSA would be expected to be the same. Finally, Applicant has not addressed the portion of the rejection that states:

a person having ordinary skill in the art at the time of invention would have appreciated that the length, width, height or mass of an object could be manipulated (increased or decreased) to manipulate (increase or decrease) the obtained specific surface area. Accordingly, as per the MPEP, "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." MPEP 2144.05(II)(A).

Therefore, the rejection with respect to claim 60 is maintained.

Applicant's remaining arguments with respect to claims 62-64 76 and 80 are equally unpersuasive for the reasons discussed above. Accordingly, the portion of the rejection not based on Mack et al. (U.S. Publication No. 2003/0224168) is maintained.

(3)

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 57-59, 75 and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu et al., *Adv. Mater.* **2002**, *14*, No. 1, January 4, Pages 64-67.

With respect to **claim 57**, Wu teaches a plurality of carbon nanowalls (nanosheets) grown on a substrate wherein the plurality of nanowalls are aligned and stand on their edges vertically to the substrate. Page 64, Col. 2, Second Paragraph and Figure 1b. Wu further teaches that the thickness of the nanowall, which is also described as a flake, is less than 10 nanometers. Page 65, Bottom of First Full Paragraph. As per the MPEP, "where the claimed ranges overlap or lie inside ranges disclosed by the prior art a *prima facie* case of obviousness exists. MPEP 2144.05(I) (internal quotations omitted).

Additionally, the Federal Circuit has made clear that "where the only difference between the prior art and the claims [is] a recitation of the relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device [is] not distinct from the prior art device." MPEP 2144.04(IV)(A).

With respect to **claim 58**, Wu teaches that the nanowall can be an unfolded single layer. Page 65, Col. 2, Middle First Full Paragraph. Additionally, with respect to the thickness, Wu teaches that the thickness of the nanowall, which is also described as a flake, is less than 10 nanometers. Page 65, Bottom of First Full Paragraph. As per the MPEP, "where the claimed ranges overlap or lie inside ranges disclosed by the prior art a *prima facie* case of obviousness exists. MPEP 2144.05(I) (internal quotations omitted).

Additionally, the Federal Circuit has made clear that “where the only difference between the prior art and the claims [is] a recitation of the relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device [is] not distinct from the prior art device.” MPEP 2144.04(IV)(A).

With respect to **claim 59**, Wu teaches that the nanowall can be an unfolded single layer. Page 65, Col. 2, Middle First Full Paragraph.

With respect to **claim 75**, Wu teaches that the nanowalls are useful in catalyst materials. Page 67, Col. 1, First Paragraph.

With respect to **claim 79**, Wu teaches that the Raman spectra of the nanowalls have a peak at 1335 cm^{-1} , which is consistent with a finding that the nanowalls comprise crystalline nanowalls. Page 65, Col. 2, Bottom of the First Full Paragraph.

(4)

Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wu et al., *Adv. Mater.* **2002**, 14, No. 1, January 4, Pages 64-67), as applied to claims 57-59, 75 and 79 above, and further in view of Peigney et al. *Carbon*, (39) 2001 505-514.

With respect to **claim 60**, Wu teaches carbon nanowalls with lateral dimensions of between 1 to 2 micrometers (which is within the claimed range of 100 nm to 8 micrometers) and that the carbon nanosheet comprises individual graphite layers, meaning the nanosheet is in substantially pure form. Wu, Figure 2 and Page 64, First Paragraph.

Additionally, it would have been obvious to a person having ordinary skill in the art at the time of invention that the specific surface area is based on the dimensions of the nanosheet and its mass. Wu teaches a substantially pure nanowall that has identical dimensions to the claimed nanosheet. Accordingly, because the nanowall is the same material and same dimensions as the claimed nanosheet, it necessarily has the same specific surface area. Specifically, the specific surface area is presumed because both Wu and the claimed nanosheet are formed of the same material, are both in substantially pure form and both have the same dimensions. Accordingly, the nanowalls taught by Wu would be expected to have a specific surface area within the claimed range.

Moreover, it would be obvious to a person having ordinary skill in the art at the time of invention that the specific surface area, which is a function of the surface area of an object and its mass can be varied to achieve a desired result. Specifically, a person having ordinary skill in the art at the time of invention would have appreciated that the length, width, height or mass of an object could be manipulated (increased or decreased) to manipulate (increase or decrease) the obtained specific surface area. Accordingly, as per the MPEP, "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." MPEP 2144.05(II)(A). Moreover, a person having ordinary skill in the art at the time of invention would make this modification because Wu teaches that the nanowalls are useful in applications requiring high surface area materials. Page 67, Col. 1, First Paragraph.

Additionally, Peigney, which deals with carbon nanostructured materials, teaches that such carbon materials would be expected to have a specific surface area within the claimed range of 1,000 m²/g to 2,600 m²/g. Page 508, Col. 2, SSA(SWNT). Specifically, in one example, Peigney teaches that the specific surface area of a SWNT is that of one side of a graphene sheet and that the SSA is 1315 m²/g, which is within the claimed range. Page 508, Col. 2, SSA(SWNT). Thus, the graphene sheet taught by Wu would be expected to have the same SSA.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of invention that the nanowalls taught by Wu have an SSA within the claimed range because Wu teaches a nanowall that is made of the same material and has the same dimensions as the claimed invention, meaning SSA, which is based on surface area (length, width height) and mass would be expected to be the same. Additionally, all the parameters used to calculate SSA are result effective variables that can be optimized to obtain a SSA in the desired range. Finally, Peigney, which is a study of nanostructured carbon materials, teaches that a graphene sheet would be expected to have an SSA of 1315 m²/g.

(5)

Claims 62-64, 76 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu et al., *Adv. Mater.* **2002**, *14*, No. 1, January 4, Pages 64-67 in view of Peigney et al. *Carbon*, (39) 2001 505-514.

With respect to **claim 62**, Wu teaches a plurality of carbon nanowalls (nanosheets) grown on a substrate wherein the plurality of nanowalls are aligned and

stand on their edges vertically to the substrate. Page 64, Col. 2, Second Paragraph and Figure 1b. Wu teaches that the nanowall can be described as a flake. Page 65, Bottom of First Full Paragraph.

Additionally, it would have been obvious to a person having ordinary skill in the art at the time of invention that the specific surface area is based on the dimensions of the nanosheet and its mass. Wu, as explained above, teaches a flake nanowall that meets the compositional requirements of the claimed invention, meaning the nanowall taught by Wu would be expected to have the same density as that of the claimed nanoflake. Accordingly, it would be obvious to a person having ordinary skill in the art at the time of invention that the specific surface area, which is a function of the surface area of an object and its mass can be varied to achieve a desired result. Specifically, a person having ordinary skill in the art at the time of invention would have appreciated that the length, width, height or mass of an object could be manipulated (increased or decreased) to manipulate (increase or decrease) the obtained specific surface area. Therefore, because Wu teaches a nanoflake with the same density as the claimed invention, the length, width and height of the nanoflake taught by Wu could be varied along with the mass to obtain a nanoflake with the desired specific surface area. Accordingly, as per the MPEP, "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." MPEP 2144.05(II)(A). Moreover, a person having ordinary skill in the art at the time of invention would make this modification because Wu teaches that the

nanowalls are useful in applications requiring high surface area materials. Page 67, Col. 1, First Paragraph.

Additionally, Peigney, which deals with carbon nanostructured materials, teaches that such carbon materials would be expected to have a specific surface area within the claimed range of $1,000 \text{ m}^2/\text{g}$ to $2,600 \text{ m}^2/\text{g}$. Page 508, Col. 2, SSA(SWNT). Specifically, in one example, Peigney teaches that the specific surface area of a SWNT is that of one side of a graphene sheet (equivalent to Wu's nanowall) and that the SSA is $1315 \text{ m}^2/\text{g}$, which is within the claimed range. Page 508, Col. 2, SSA(SWNT). Thus, the graphene sheet taught by Wu would be expected to have the same SSA.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of invention that the nanowalls taught by Wu would have an SSA within the claimed range because Wu teaches a nanowall that is made of the same material as the claimed invention, meaning SSA, which is based on surface area (length, width height) and mass would be expected to be the same can be obtained by optimizing the nanowall to a desired length, width or height. Finally, Peigney, which is a study of nanostructured carbon materials, teaches that a graphene sheet would be expected to have an SSA of $1315 \text{ m}^2/\text{g}$.

With respect to **claim 63**, Wu further teaches that the thickness of the nanowall, which is also described as a flake, is less than 10 nanometers. Page 65, Bottom of First Full Paragraph. As per the MPEP, "where the claimed ranges overlap or lie inside ranges disclosed by the prior art a *prima facie* case of obviousness exists. MPEP 2144.05(I) (internal quotations omitted).

With respect to **claim 64**, Wu and Peigney, as combined above, establish that the parameters of the nanoflake (height, width, length) can be optimized to obtain a nanoflake with the desired specific surface area. Col. 1, First Paragraph. Accordingly, as per the MPEP, "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." MPEP 2144.05(II)(A). Moreover, a person having ordinary skill in the art at the time of invention would make this modification because Wu teaches that the nanowalls are useful in applications requiring high surface area materials. Page 67, Col. 1, First Paragraph.

With respect to the thickness of the nanoflake, Wu teaches that the thickness of the nanowall is less than 10 nanometers. Page 65, Bottom of First Full Paragraph. As per the MPEP, "where the claimed ranges overlap or lie inside ranges disclosed by the prior art a *prima facie* case of obviousness exists. MPEP 2144.05(I) (internal quotations omitted).

Additionally, the Federal Circuit has made clear that "where the only difference between the prior art and the claims [is] a recitation of the relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device [is] not distinct from the prior art device." MPEP 2144.04(IV)(A).

With respect to **claim 76**, Wu teaches that the nanowalls are useful in catalyst materials. Page 67, Col. 1, First Paragraph.

With respect to **claim 80**, Wu teaches that the Raman spectra of the nanowalls have a peak at 1335 cm^{-1} , which is consistent with a finding that the nanowalls comprise crystalline nanowalls. Page 65, Col. 2, Bottom of the First Full Paragraph.

(6)

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). Examiner notes that no new ground or theory of rejection is presented in this Office Action. A previous ground of rejection has been withdrawn and the Office Action has been appropriately re-formatted.

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **ELI S. MEKHLIN** whose telephone number is (571)270-7597. The examiner can normally be reached on 5/4/9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer K. Michener can be reached on 571-272-1424. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ELI S MEKHLIN/
Examiner, Art Unit 1728

/Jennifer K. Michener/
Supervisory Patent Examiner, Art Unit 1728